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IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE

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Application Number: 09/478,299  
Applicants: John L. Schenk  
Filed: January 5, 2000  
Title: Method of Cryopreserving Selected Sperm Cells  
Group Art Unit: 1654  
Examiner: M. Meller  
Assignee: XY, Inc.  
Attorney Docket: 22091-701  
Customer No.: 33549

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**FIRST SUPPLEMENT TO  
REQUEST FOR CONTINUED EXAMINATION OF AUGUST 9, 2006**

This submission is a First Supplement to the Request for Continued Examination filed in the above-referenced case on August 9, 2006. The Request for Continued Examination was filed pursuant to 37 C.F.R. § 1.114 in response to an Office Action dated February 9, 2006, and was filed with an appropriate petition for extension of time. In addition, this First Supplement to the Request for Continued Examination is filed in response to the personal interview held on September 18, 2006 between Examiner Meller and Mr. Santangelo.

This First Supplement is submitted to provide data and certification of data by John L. Schenk and a supplemental information disclosure statement.

Although not raised in the action, the following may be noteworthy. Salisbury, G. W. and VanDemark, N. L. "Physiology of Reproduction and Artificial Insemination of Cattle." San Francisco: Freeman and Company. p. 442-551 (1978), Chapters 16 and 17, herein referred to as "Salisbury" and US Pat. No. 5,021,244 to Spaulding, herein referred to as "Spaulding" does not anticipate nor make obvious the claims of the present application. Page 477 of the Spaulding reference discusses extended samples to 5, 10, and 15 million motile cells per milliliter. This discussion does not explicitly nor implicitly state that these extended samples use sperm cells that have been sorted and even that the extended samples will be cooled and frozen.

Accordingly, the reference does not disclose, *inter alia*, sorting of sperm cells, cooling the sex-selected sperm cells, suspending sperm cells in an extender to about 5 million per milliliter of extender to about 10 million per milliliter of extender, freezing the sex-selected sperm cells in an extender, and as further discussed in the claims of the present application.

In addition, the Spaulding reference, alone or perhaps even in combination with the Salisbury reference, does not disclose or make obvious the invention as claimed. The Spaulding reference does not disclose, *inter alia*, sorting of sperm cells using flow cytometry or fluorescence-activated cell sorting, suspending the sex-selected sperm cells in an extender to about 5 million per milliliter of extender to about 10 million per milliliter of extender and freezing the sex-selected sperm cells in an extender, and as further discussed in the claims of the present application. To reiterate, as one example, the Spaulding reference does not discuss freezing of sperm cells that have been sorted by flow cytometry or fluorescence-activated cell sorting of which the sperm cells have been suspended in about 5 million per milliliter of extender to about 10 million per milliliter of extender. Further, since the Salisbury and Spaulding references do not disclose all of the elements of the claimed invention, they do not anticipate nor make obvious the claimed invention.

In further support, it is noted that the Affidavit by John L. Schenk filed on January 20, 2006 discusses how the Spaulding and Shrimpton references are not capable of being successfully reproduced. Accordingly, the Affidavit asserts that the references are inoperable by a preponderance of the evidence by demonstrating that one skilled in the art would have been unable to successfully produce the techniques as discussed in the Spaulding and Shrimpton references. *See, In re Sasse*, 629 F.2d 675, 207, USPQ 107 (CCPA 1980).

Dated this 2<sup>nd</sup> day of October, 2006.

Respectfully submitted,  
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